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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,722	03/30/2001	Dale Tyson Roberts	1364.1001D2C	5204

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EXAMINER

VU, VIET DUY

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,722

Applicant(s)

ROBERTS ET AL.

Examiner

Viet Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-44 and 61-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 9-44 and 61-65 is/are rejected.
- 7) ☒ Claim(s) 7, 8 and 66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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Art Rejections:

1. The texts of 35 USC 103(a) not cited here can be found in the previous office action.

2. Claims 2-6, 9-12, 14-44 and 61-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary et al, U.S. pat. No. 5,774,664.

Per claim 2, Hidary discloses system and method for associating local and remote data on a computer comprising:

a) a computer terminal for accessing/playing a (broadcast or recorded) audio/video program (see col 4, lines 28-39),

b) a decoder for dynamically determining/abstracting a plurality of identifiers (e.g., URLs, server addresses) from information associated/embedded with the program where the embedded information was not stored to identify the playing program (col 4, lines 40-67 and col 5, lines 25-46),

c) means for outputting/displaying the complimentary content obtained from a remote location using the determined identifiers (see col 7, lines 60-65).

Hidary also teaches playing the program from a recording medium (e.g., VHS tapes, DVDs) instead of from a broadcasting source (see col 9, lines 3 - col 10, line 2).

Hidary does not explicitly show a playback unit for playing recorded program on a recording medium. An official notice is taken that such playback unit is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide such a playback in Hidary because it would have enabled playing a audio/video program recorded on a recording medium (see col 9, lines 3 - col 10, line 2).

Per claims 3-4, it is noted that many URLs are used as partial pointers to locate the information on the web. For instance, a URL to a home page is a partial pointer to locate a particular page that is accessible from the home page.

Per claims 5-6, Hidary also discloses a communication unit, responsive to the playing of the broadcast/recorded program, for automatically executing a communication program to download the complimentary contents, e.g., web contents, from a remote location (e.g., web server) over a network using the determined identifiers (see Hidary in col 7, lines 11-29).

Per claims 9-12, it would have been further obvious to one skilled in the art to recognize that any complimentary data contents in any conventional formats, e.g. text, audio, video, would have been provided to the recording/program including album titles and song names.

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Per claim 14, Hidary teaches decoding (abstracting) data associated with the program content to obtain the identifiers (see col 5, lines 25-42). It would have been further obvious to one skilled in the art to store or embed the identifiers onto the program content using any conventional encoding methods.

Per claim 15, Hidary teaches a communication unit, in response to the playing of the broadcast or recorded program, automatically executing a communication program to download web contents, from a remote location (see Hidary in col 7, lines 11-29). Hidary does not explicitly teach verifying access of the disc by the communication program.

It would have been obvious to one skilled in the art to recognize such verification step because it would have enabled computer terminal to start the communication program for downloading web contents from the Internet (see Hidary in col 7, lines 11-29).

Per claim 16, Hidary does not explicitly teach prompting input of a disc. An official notice is taken that the step of prompting input of a disc, when the user tries to start the program without having the disc in the drive, is well known in the art.

It would have been obvious to one skilled in the art to utilize such prompting step in Hidary because it would have enabled proper operation of the program and/or the disc drive.

Hudetz also teaches comparing the identifiers with records in the index database (see Hudetz in col 7, lines 1-28).

Claims 17-44 and 61 are similar in scope as that of claims 2-6, 9-12 and 14-16.

Per claim 62, it is obvious to one skilled in the art that supplemental data related to the program would have included program identifiers such as song/album titles. It is also noted that the use of such identifiers, i.e., song titles, as keywords to search for information relating the song on the Internet is well known in the art.

Per claims 63-65, it is further noted that an Internet search result usually comprises a list of sites and/or documents that are approximately matched the searched keyword/identifier.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary and further in view of Hudetz et al, U.S. pat. No. 5,978,773.

Hidary does not teach providing an index database for maintaining URLs related to a product or service. Hudetz teaches using of such index database to store URLs related to a product

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or service more effectively, i.e., providing addresses that are independent from content providers' addresses (see Hudetz in col 4, lines 19-30 and col 7, line 1-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hidary with Hudetz's teachings because it would have alleviated the problems of storing/encoding network addresses onto prerecorded media where such addresses could be changed at a later time (see Hudetz in col 4, lines 19-30).

It is noted that Hudetz teaches comparing the identifier with records in the database in response to a query (see Hudetz in col 7, lines 17-57).

Allowable Subject Matter:

4. Claims 7-8 and 66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment:

5. Applicant's arguments filed on 4/25/05 with respect to claims 2-6, 9-44 and 61-65 have been fully considered but they are not found persuasive.

Applicant asserts that Hidary does not teach deriving an identifier from content of the recording that is not stored to identify the program.

The examiner disagrees. It is noted that the URLs embedded within the broadcast program in Hidary are not merely used to identify the program itself. Rather, they can be used to identify information related to the program (see col 8, lines 18-44).

It is also noted that while the URLs maybe predetermined at the broadcaster or program recorder, these URLs are dynamically decoded and determined by the user's terminal at the time program is played to download supplemental web contents from the Internet.

Applicant also asserts that Hidary fails to teach deriving the identifier by abstracting information associated with the recording.

The examiner submits that Hidary teaches decoding encoded content in the broadcast/recorded program to obtain the URLs meets the claim limitations.

Conclusion:

6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P.

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 571-272-3977. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on 571-272-3964.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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6/20/05

VIET D. VU
PRIMARY EXAMINER